

## **REMARKS**

After entry of the foregoing amendment, claims 1, 3-5 and 17-41 remain pending in the application.

Claims 1 and 32-39 stand rejected for indefiniteness in view of the terms “a particular physical device,” “second physical device, and “electronic data store.”

Applicants have removed the term “particular” from independent claims 1 and 32.

Regarding the “first physical device,” this limitation is supported, e.g., by the specification’s disclosure of the “originating device 12” depicted in Fig. 2. Fig. 3 further details an illustrative “originating device 12,” which can be seen to include a sensor, interface electronics, and various software applications. In the paragraph at the bottom of page 3, the specification explains that the originating device 12 can take many different forms, e.g., a cell phone, a Palm Pilot, a personal computer, a barcode scanning system, etc. All of these are physical devices.

Similarly, the “second physical device” is supported by the specification’s disclosure of the “product handler 16” depicted in Fig. 2. As detailed in the specification, e.g., at page 6, lines 15-16 (referring back to page 5, lines 9-15), the “product handler 16” can comprise a computer including one or more CPUs, memory, disks and I/O ports, operating in accordance with operating system software and application programs.

Again, the detailed product handler is a physical device.

The “electronic data store” is supported, e.g., by “registration database 17” shown in Fig. 3. As is familiar to artisans, a database is a data store.

While the claim does not use the identical terminology as the specification, this is permitted. The claims needn’t use the same terminology as the specification. *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in *ipsis verbis* to be sufficient").

All of the claims stand rejected as non-statutory under Section 101. The rejection is respectfully traversed.

As just noted, claims 1 and 32 include multiple recitations of hardware devices.

Likewise, claim 3 recites “registration means,” “originating device means,” “routing means,” and “product handler means.” Under *Donaldson*, these “means plus function” claims are to be construed to cover the corresponding structure disclosed in the specification, and structural equivalents. The specification discloses hardware for each of these elements. There is no disclosure in the specification that would support an interpretation of claim 3 to cover software *alone*.

Similarly with claim 17. It requires, e.g., “querying a database,” and interaction with “physical objects.” Again, no software-only implementation is possible (nor can the method be practiced by mental steps alone).

Likewise with claim 23, which recites “a first device,” “a second device,” and various objects.

So, too, with claims 24 and 30, which recite, e.g., “a physical object,” and “a database.”

Nonetheless, to help expedite this prolonged prosecution, applicants have amended various of the claims to add still further hardware recitations.

(Certain of the claims are expressed in Jepson format, and some hardware recitations are found in these claims’ preambles. However, in the case of Jepson claims, limitations appearing in the claim preamble are considered positively and clearly included as part of the claimed combination. *See MPEP § 608.01(m), 6<sup>th</sup> para.*)

In sum, none of Applicants’ claims can be practiced by software or mental steps alone. All involve specified apparatus.

Claims 17, 19, 21-24, 26, and 28-31 stand rejected over Weiss (7,065,559) in view of Madsen (6,941,338).

Regarding independent claim 17, neither Weiss nor Madsen teaches “... sending address information associated with such foreseen object payloads after sending address information associated with the first object.”

As to independent claim 23, the cited art does not teach “after initiating said link, identifying additional objects...”

As to independent claim 24, the art does not teach “sending address information associated with such foreseen object payloads after initiating said electronic link.”

As to independent claim 30, the art does not teach “foreseeing information about object payloads that may be forthcoming, and the order in which said other object payloads may be forthcoming, and anticipatorily sending address information associated with such foreseen object payloads, in such order.”

Because the art does not teach the underlined aspects of the rejected independent claims, Applicants respectfully submit that threshold showings of obviousness have not been established.

(These distinctions were noted in the previous response, and were not addressed in the *Response to Arguments* section of the most recent Action. If the rejections are renewed, the Office is requested to address the foregoing distinctions in such as *Response*.)

For brevity's sake, these remarks have only addressed certain of the claims, have addressed only certain aspects of the Action, and have detailed only certain of the distinctions between the claims and the art. However, such discussion is believed sufficient to establish the allowability of all pending claims. Thus, applicant does not

further belabor this paper with other arguments concerning the rejections, the art, and the claims – all of which are reserved for possible presentation to the Board.

Date: December 2, 2009

**CUSTOMER NUMBER 23735**

Phone: 503-469-4800  
FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By /William Y Conwell/  
William Y. Conwell  
Registration No. 31,943